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| 09/800,621 | 03/07/2001 | Bernard G. Freeland | A2A-101 | 7479 |

7590
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04/04/2007

EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3693

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 09/800,621 | Applicant(s) FREELAND, BERNARD G. | |
| | Examiner Harish T. Dass | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/8/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, , as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added negative limitation "without previously having taken title to the asset" is not presented in originally submitted specification. However the limitation is added in preamble (see *In re Hirao*), Examiner is unable to find any paragraph that described the new added negative limitation. See *In re Wakefield* and *In re Barr* (MPEP section 2173.05(i)). The closes phrase that examiner can find (page 11 of original specification) which reads "The system agent 14 in the center of the diagram brings a buyer 10 and a seller 12 together, and without taking title to the property, provides fee-based services to the buyer and seller to facilitate the sale of an item, is different than what is added in preamble.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (hereinafter Anderson – 5,774,883) in view of Regan (US 6,898,574).

Re. Claim 1, Anderson discloses validating a titled asset to be sold by a seller to a buyer [see entire document particularly, Abstract],

arranging for financing by a lender of funds to be paid to a seller for said asset on behalf of a buyer [Figures 12-13a, 14; C1 L64 to C2 L12], all of said steps taking place without an intermediate transfer of ownership of said asset from said seller to any party other than said buyer [C2 L6-L9]. Anderson does not explicitly disclose providing an escrow service for ensuring that financial and legal aspects of said sale occur in an orderly manner. However, Regan discloses this feature [Figure 1; col. 2 lines 50-63; col. 3 lines 18-68; col. 4 lines 30-50; col. 9 lines 9-33] to provide an automatic online service and transaction process to participant efficiently. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and include providing an escrow service, as disclosed by Regan, to provide an integrated system for escrow, registration, appraisal, etc. Further, it is obvious that title of vehicle is transferred between the seller and buyer, even the vehicle has lien on it. Title is never transferred to an agent who help the transaction between seller and buyer and gets commission. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the

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disclosure of Anderson and Regan and include a negative clause, such as above, to prevent fraud.

Re. Claim 2, Anderson discloses wherein said validation comprises an examination of the asset and creation of descriptive information regarding the asset and its condition, and recording said descriptive information in a report [abstract; C5 L45-L50]. Further, it is well known that when a used car is purchase buy the car dealer, the dealer inspect the car to appraise the car, and when an individual buys a car from another person, he/she takes the car for inspection to auto-repair shop to find out the condition of the car. For example, car max checks every car and provide recommendation.

Re. Claim 3, Anderson discloses wherein said validation comprises an inspection of the asset and a recommendation for repairs or alterations of the asset [C19 L1-L3].

Re. Claim 8, Anderson discloses validating a titled vehicle to be sold by a seller to a buyer, said validating including an inspection of said vehicle to confirm its make, model and condition [Figures 12-13a, 14; C1 L64 to C2 L12; C5 L45-L50], arranging for financing by a lender of funds to be paid to a seller for said vehicle on behalf of a buyer [C18 L25-L57; C26 L1-L23], and all of said steps taking place without an intermediate transfer of ownership of said vehicle from said seller to any party other than said buyer [C2 L6-L9]. Anderson does not explicitly disclose providing an escrow service in which an agent coordinates said sale, and makes arrangements for said vehicle and title to

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said vehicle to be transferred to the buyer, arranges for purchase funds to be given to the seller of said vehicle, and attends to satisfaction of any liens with respect to the seller's ownership of said vehicle, and attends to recordal of any liens to be made by a lender of funds to said buyer on said title. However, Regan discloses these step [see entire document particularly, Figure 1; col. 2 lines 50-63; col. 3 lines 18-68; col. 4 lines 30-50; col. 6 line 60 to col. 7 line 9; col. 9 lines 9-33] to provide an automatic online service and transaction process to participant efficiently. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and include providing an escrow service and above feature, as disclosed by Regan, to provide an online integrated client/server system for escrow/title, registration, appraisal, and transaction process of vehicle to participant efficiently. Further, it is obvious that title of vehicle is transferred between the seller and buyer, even the vehicle has lien on it. Title is never transferred to an agent who help the transaction between seller and buyer and gets commission. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and Regan and include a negative clause, such as above, to prevent fraud

Re. Claim 9, Anderson wherein said validating comprises preparation of a descriptive information report with recommendations for maintenance, repair and/or alteration of said vehicle [C19 L1-L3].

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Re. Claim 10, claim 10 is rejected with same rational as claim 1.

Re. Claim 11, Anderson discloses wherein said validation service comprises an examination of the asset by a technician familiar with assets of the type to be sold, and said technician creates a written report containing descriptive information regarding the asset and its condition [abstract; C5 L45-L50].

Re. Claim 12, Anderson discloses wherein said asset is a vehicle and validation comprises an inspection of the vehicle and a recommendation for repairs or alterations of the vehicle [C19 L1-L3].

Claims 4-7 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Regan as applied to claims 1, 10 above, and further in view of Finch (US 6,850,902).

Re. Claims 4-7, Anderson discloses wherein said method includes additional steps selected from the group consisting of: providing tag and title services in which requirements for licensing and registration of the asset with governmental officials are fulfilled (documents) [C17 L30-L44; C18 L25-L57], wherein said method includes providing tag and title services in which requirements for licensing and registration of the asset with governmental officials are fulfilled (documents) [C17 L30-L44; C18 L25-L57]. Neither Anderson nor Regan explicitly discloses resolving liens held by previous

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lenders of money to said seller by paying all monies owed lien holders existing at the time of sale, and attending to recordal (history) of new liens associated with borrowing by said buyer, and wherein said method includes resolving liens held by previous lenders of money to said seller by paying all monies owed lien holders existing at the time of sale, and wherein said method includes attending to recordal (history or history record) of new liens associated with borrowing by said buyer. However, Finch discloses these features [see entire document particularly Abstract; Figures 2, 4, & 6; C1 L32-L50; C3 L13-L60] to release of a lien formally held by a lender and transfer title to new owner. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Anderson and Regan and include resolving liens held by previous lenders, as disclosed by Finch to satisfy the old loans for clean title transfer to new owner.

Re. Claims 13-16, claims 13-16 are parallel claims to claims 4-7 and are rejected with same rational as claims 4-7.

Response to Arguments

Examiner thank the applicant for pointing out the typo error in claim 8 "Business Wire" should have been Regan.

In response to applicant's argument (page 6 remarks) that Regan is nonanalogous art, "In order to rely on a reference as a basis for rejection of an

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applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); * Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)>; and State Contracting & Eng 'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). In this case, Regan deals with lending, escrow, lien and title of vehicle, on-line processing of transactions that the current application is concern with.

In response to applicant's argument Regan does not disclose providing an escrow service, see Regan col. 4 lines 30-50.

In response to applicant's argument Andersen does not disclose the validating steps or services of claims 1, 8, and 10. Anderson inherently validates titles asset, see Abstract

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for example, "validating the sale of an asset", where the asset is a titled asset "vehicle".

Dealer, agent has to verify the correct title to prevent fraud.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass
Examiner
Art Unit 3693

Harish T Dass

3/24/07